

REMARKS

Claims 1-21 were submitted for examination. Claims 1-21 have been rejected. Reconsideration and reexamination of the above-referenced patent application is respectfully requested in view of the following remarks.

Rejection Under 35 USC §103 Over Ichimura et al. and Kikinis et al.

Claims 1-9, 12-14, 17-19 and 21 have been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,648,762 of Ichimura et al. ("Ichimura ") in view of U.S. Patent No. 5,793,957 of Kikinis et al. ("Kikinis").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims 1, 12, and 17, include limitations that are not disclosed nor suggested by the Ichimura or Kikinis references. As a result, Applicant's independent claims are patentable over the Ichimura and Kikinis references.

In particular, Applicant's independent claims 1, 12, and 17, include the limitation of, or a limitation similar thereto, *of a device having a processor to operate as a system processor of the notebook computer when the device is docked and to operate as a system processor of the device when the device is undocked.*

Contrary to the Examiner's position, Kikinis does not disclose a notebook computer with a docking bay for a device that includes a processor, which operates as

a system processor of the notebook computer when the device is docked and operates as a system processor when the device is undocked. Rather, the Kikinis disclosure is limited to disclosing a notebook computer with a docking bay for a PCMCIA card, not a device with a system processor, as is claimed by Applicant.

The Examiner further states that one of ordinary skill in the art would have been motivated to replace the desktop disclosed in Ichimura with a notebook computer because a notebook computer is more portable. However, to do so would destroy the intended function of Ichimura.

If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modifications. *In re Gordon*, 733 Fed. 2d 221 USPQ 1125 (Fed. Circuit. 1984). (MPEP §2143.01).

As stated to modify Ichimura as suggested by the Examiner would destroy the intended function of Ichimura. The intended function of Ichimura is to provide a desktop computer that is able to dock a laptop computer. The motivation is to provide docking by a non-mobile computer (e.g. desktop computer) for a mobile computer. (Ichimura, col. 1, lines 24-30). The motivation for Ichimura for docking laptop to a desktop is that the desktop is not mobile as is the desktop. (Ichimura, col. 1, lines 24-30). Therefore, to replace a desktop computer with a mobile computer to simply dock a second mobile computer in the first mobile computer would destroy the intended purpose of Ichimura.

Additional Rejections Under 35 USC §103

Claims 10, 11, 15 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,648,762 of Ichimura et al. ("Ichimura ") and U.S.

Patent No. 5,793,957 of Kikinis et al. ("Kikinis") in view of U.S. Patent No. 5,884,049 of Atkinson.

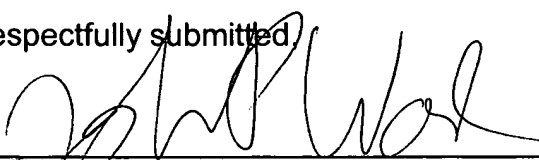
Claims 16 has been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,648,762 of Ichimura et al. ("Ichimura ") and U.S. Patent No. 5,793,957 of Kikinis et al. ("Kikinis") in view of U.S. Patent No. 5,754,798 of Uehara et al.

Applicant's remaining claims depend from at least one of the independent claims discussed above, and therefore include the distinguishing claim limitations as discussed above. As a result, Applicant's remaining claims are also patentable over Ichimura, Kikinis, Atkinson, and Uehara.

Conclusion

In view of the amendments, including broadening amendments, and remarks set forth above, Applicants respectfully submit that the now pending claims are in condition for allowance.

Respectfully submitted,



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APPENDIX A
VERSION OF SPECIFICATION AND CLAIMS
WITH MARKINGS TO SHOW CHANGES MADE
IN THE SPECIFICATION

Paragraph starting on page 5, line 17 is amended as follows:

(Amended) Figure 2 is a schematic diagram of notebook computer 100 and core computer 101 when the core computer is docked in the notebook computer. Core computer 101 includes core processor 200 coupled to core hub 205. Core hub 205 enables communication between core processor 200 and core memory 210, core output controller 215, and core input controller 220 to which it is coupled. Core hub 205 is also coupled to interface 260. In addition, core computer 101 includes battery 255 coupled to interface 260. Notebook computer 100 includes notebook hub 230 to enable communication between core hub 205, via interface 260, and notebook memory 235, notebook output controller 240, and notebook input controller 245 to which notebook hub 230 is coupled. In addition, notebook computer [10] 100 includes notebook power supply 250 coupled to interface 260.